

REMARKS**Amended Claims**

Claims 1-2, 11 and 13-15 are amended herein.

Claim Rejections Under 35 U.S.C. § 112

Claims 1-11, 13 and 14 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses the rejections.

The Examiner rejected claims 1-11 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner specifically rejected claim 1 for referencing “the image device” on both lines 4 and 7 of the claim, stating that it was unclear if these were the same imaging device.

Applicant respectfully disagrees with the Examiner’s rejection and notes that line 4 of claim 1 introduces “an imaging device” and as such, “the imaging device” of line 7 has proper antecedent basis and is therefore definite. However, in the interest of furthering prosecution Applicant has amended claims 1-2 and 11 herein to clarify the claims and overcome the rejection under 35 U.S.C. §112, second paragraph. Specifically, claims 1-2 and 11 were amended to replace “the imaging device” with “the first imaging device”.

Applicant thus contends that relevant features of claim 1 are definite and described in the specification to enable one skilled in the art to practice the invention. Applicant also contends that, as claims 2-11 depend from and further define claim 1, they are also considered definite and enabled.

The Examiner also rejected claims 13 and 14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that claims 13 and 14 recite a “computer usable media” and noted that it was unclear as to which statutory category, “manufactures” or “process”, this was under 35 U.S.C. §101. Applicant notes that MPEP §2106(IV)(B)(1) states that for computer related inventions “[w]hen functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” Applicant thus respectfully maintains that the “Beauregard”-style of

claims 13 and 14, while encoding a process, are therefore items of manufacture and statutory under 35 U.S.C. §101. *See*, MPEP §2106(IV)(B)(1) and MPEP §2106(II)(A).

Applicant thus contends that relevant features of claims 13 and 14 are definite and are described in the specification to enable one skilled in the art to practice the invention.

Applicant therefore respectfully requests that the rejection of claims 1-11, 13 and 14 under 35 U.S.C. § 112, second paragraph, be withdrawn in that the claims are not indefinite and that the specification does clearly describe the invention in a way to enable one skilled in the art to make or use the invention.

Claim Objections

Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. Claim 14 further limits the “method of claim 13”, but does not require the computer-usable medium of claim 13. Therefore, claim 14 fails the infringement test for proper dependent claims.

Applicant respectfully notes that Claim 14, as amended, recites the limitation of “The computer-usable medium of claim 13”. As such, Applicant respectfully maintains that the requirements of 35 CFR 1.75(c) have been met. The Applicant therefore requests that the Examiner’s objection of claim 14 under 35 CFR 1.75(c) be withdrawn.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-11 and 13-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Danknick (U.S. Patent No. 6,021,429). Applicant respectfully traverses this rejection and submits that claims 1-11 and 13-20, as amended, are allowable for the following reasons.

Applicant respectfully maintains that Danknick discloses a network device that discovers and stores a list of all networked devices on a local area network and does not teach or disclose an imaging device that stores a list of other imaging device network addresses and communicates the list of other imaging device network addresses through a network interface to an imaging device management facility. Applicant further maintains that Danknick does not disclose an embedded webserver at Column 8, Lines 29-65, but a standalone program used by the network administrator. *See*, Danknick, Figures 1-2, and 5A-5B; Abstract;

Column 7, line 25 to Column 8, line 65. Applicant therefore respectfully submits that Danknick fails to teach or disclose all elements of the Applicant's claimed invention.

Applicant's claim 1, as amended, recites "[a]n imaging device comprising: an image generator, wherein the image generator is a print engine internal a first imaging device; a network interface, wherein the network interface is adapted to couple the first imaging device to a network; and a controller coupled to the network interface and the image generator, wherein the controller is internal to the first imaging device and is adapted to store a list of other imaging device network addresses; wherein the controller is adapted to communicate the list of other imaging device network addresses through the network interface to an imaging device management facility upon request." As detailed above, Applicant submits that Danknick fails to teach or disclose such an imaging device that is adapted to store a list of other imaging device network addresses that is adapted to communicate the list of other imaging device network addresses through the network interface to an imaging device management facility upon request. As such, Danknick fails to teach or disclose all elements of claim 1.

Applicant's claim 13 recites "[a] computer-usable medium having computer readable instructions stored thereon for execution by a processor of an imaging device to perform a method comprising: determining a list of network addresses for other imaging devices similar to a first imaging device, wherein the first imaging device contains a print engine; storing the list of network addresses on the first imaging device; communicating with the other similar imaging devices by referring to the list of network addresses for the other imaging devices; and communicating the list of other imaging device network addresses through a network interface to an imaging device management facility." As detailed above, Applicant submits that Danknick fails to teach or disclose such a computer-usable medium and method for execution by a processor of an imaging device to store a list of other similar imaging device network addresses and communicate the list of other imaging device network addresses through a network interface to an imaging device management facility. As such, Danknick fails to teach or disclose all elements of claim 13.

Applicant's claim 15 recites "[a] method of operating an imaging device, the method comprising: determining a list of network addresses for other imaging devices similar to a first imaging device, wherein the first imaging device contains a print engine; storing the list of network addresses on the first imaging device; referring to the list of network addresses of other imaging devices for communication between imaging devices; and communicating the list of other imaging device network addresses through a network interface to an imaging device

management facility.” As detailed above, Applicant submits that Danknick fails to teach or disclose such a method of operating an imaging device that determines and stores a list of other similar imaging device network addresses and communicates the list of other imaging device network addresses through a network interface to an imaging device management facility. As such, Danknick fails to teach or disclose all elements of claim 15.

Applicant respectfully contends that claims 1, 13 and 15, as pending, has been shown to be patentably distinct from the cited reference. As claims 2-11, 14 and 16-20 depend from and further define claims 1, 13 and 15, respectively, they are also considered to be in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) and allowance of claims 1-11 and 13-20.


CONCLUSION

In view of the above remarks, Applicant believes that all pending claims are in condition for allowance and respectfully requests a Notice of Allowance be issued in this case. Please charge any further fees deemed necessary or credit any overpayment to Deposit Account No. 08-2025.

If the Examiner has any questions or concerns regarding this application, please contact the undersigned at (612) 312-2207.

Respectfully submitted,

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Andrew W. Walseth
Reg. No. 43,234

Attorneys for Applicant
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
3404 East Harmony Road
Fort Collins, CO 80527-2400